UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE A. GNADE and ROBERT M. WALLACE



Appeal No. 2006-0502
Application No. 10/051,970

ON BRIEF

Before WARREN, WALTZ and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we determine that the above-identified application is not ready for a decision on appeal under 35 U.S.C. § 134 (2003). Accordingly, we remand this application to the examiner for further consideration and action not inconsistent with our opinion below. 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

At page 3 of the answer, the examiner maintains that:

> claims 11-60 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

However, at the time of filing of appellants' brief (May 11, 2005), 37 CFR § 1.192(c) was no longer in effect, having been replaced by 37 CFR § 41.37 (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). In this regard, new rule 37 CFR § 41.37 (c)(vii) provides, in part, that:

> For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

Here, we observe that the examiner maintains three separate grounds of rejection in the answer with each ground of rejection being applied to different groupings of claims. Also, appellants have addressed each separate ground of rejection under separate headings in the brief. Thus, the examiner's statement that all of the appealed claims stand or fall together is in error not only because the examiner applied the incorrect rule, but as a result of the necessity to address the claims subject to each ground of rejection, which pertain to different sets of claims, separately, as was the case even under the replaced rule, 37 CFR § 1.192(c)(7). See In re McDaniel, 293 F.3d 1379, 1383-84, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002), wherein our reviewing court, stated:

> 37 C.F.R. §1.192(c)(7) does not give the Board carte blanche to ignore the distinctions between separate grounds of rejection and to select the broadest claim rejected on one ground as a representative of a separate group of claims subject to a different ground of rejection. The applicant has the right to have each of the grounds of rejection relied on by the Examiner reviewed independently by the Board under 35 U.S.C. §6(b) (providing that "[t]he Board of Patent Appeals and Interferences *shall* ... review adverse *decisions of examiners* upon applications for patents") (emphasis added). Simplification and expedition of appeals cannot justify the Board's conflating separately stated grounds of rejection by selecting, for the purpose of deciding an appeal as to one ground of rejection, a representative claim which is not itself subject to that ground of rejection. 37 C.F.R. §1.192(c)(7) does not override an applicant's right under the statute to have each

> contested ground of rejection by an examiner reviewed and measured against the scope of at least one claim within the group of claims subject to that ground of rejection. *See* 35 U.S.C. §6(b) (2000).

Aside from that error, the examiner has not separately addressed at least all of the claims that are argued separately with respect to each of the separate grounds of rejection. For example, appellants present separate arguments for three groupings of claims for each of the examiner's separate anticipation grounds of rejection at pages 6-8 of the brief, yet the examiner does not correspondingly address claims from each of those multiple claim groupings as argued for each separate anticipation rejection. Indeed, for the secondly presented anticipation rejection set forth at page 6 of the answer, the examiner generally refers us to the abstract, Introduction, Discussion and Conclusion of the reference article being applied in that rejection. Then, the examiner refers us to the reasoning of the first stated anticipation rejection involving a different reference for explaining the application of the second reference in the second anticipation rejection. That is hardly a detailed application of the particular teachings of the second reference

to each of the rejected claims identified in the examiner's second anticipation rejection.[1]

In addition, the examiner refers to material obtained from a website at page 8 of the answer without identifying the date of public availability thereof. In this regard, we remind the examiner that any references relied upon should be identified in the statement of the rejection. Moreover, we note that the issue as to the scope of the claim terms "chemical toxin" and "biological toxin" should not be addressed by merely referencing a web site definition of applied references' terms. Rather, the examiner should be determining the scope of the contested claim terms by taking into account the usage of those claim terms in the claims themselves, when read as a whole, taking into account how those same terms are used in appellants' specification, as they would be understood by one of ordinary skill in the art. Also, any specific definitions of those terms, if furnished in appellants' specification, should be given primacy in determining the meaning thereof in determining the broadest reasonable scope

[1] As an additional matter, we note that the examiner erroneously includes cancelled claims 2, 3, 7 and 8 in the obviousness rejection set forth at pages 6 and 7 of the answer.

of the claimed subject matter consistent with current patent jurisprudence.

In light of the above, this application is not in condition for a decision on appeal at this time. On return of this application, the examiner should take appropriate action to correct the deficiencies identified above.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

Additionally, this application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D)(8th ed., Rev. 2, May 2004). Thus, it is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

CHARLES F. WARREN )
Administrative Patent Judge )
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THOMAS A. WALTZ )
Administrative Patent Judge ) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
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